

### **Introductory Comments**

In the non-final office action mailed August 30, 2006, claims 50-55 and 58-62 were pending, claims 58-62 were withdrawn from consideration, and claims 50-55 were rejected. With this amendment, claims 50, 52, 54 and 55 have been amended, claims 58-62 have been cancelled without disclaimer or waiver of the subject matter recited therein, and new claims 63-79 have been added. Accordingly, claims 50-55 and 63-79 are currently pending in the subject application. In view of the following amendments and remarks, reconsideration and allowance of the subject application are hereby requested.

## **REMARKS**

### **Election/Restrictions**

Claims 58-62 have been withdrawn from consideration as being drawn to a non-elected invention and species of the invention. The Applicants have cancelled claims 58-62 without prejudice for possible submission in a continuing application.

### **Double Patenting**

Claim 50 has been rejected under the judicially created doctrine of obviousness-type double patenting over claim 7 in commonly owned U.S. Patent No. 6,610,065. In response to the obviousness-type double patenting rejection, the Applicants have submitted a Terminal Disclaimer herewith along with the requisite fee, and respectfully request withdrawal of the double patenting rejection.

### **Information Disclosure Statement**

The Examiner did not consider the foreign patent references and the non-patent references cited in the Information Disclosure Statement filed on August 21, 2003 because copies were not provided. The Applicants submit herewith a Supplemental Information Disclosure Statement citing the foreign patent references and the non-patent references cited in the previously submitted Information Disclosure Statement. All of the foreign references and non-patent references indicated in the Supplemental Information Disclosure Statement filed herewith were previously considered in U.S. Patent Application Serial No. 09/870,023 to which the present application claims priority, and therefore under 37 C.F.R. § 1.98(d) copies are not required. Accordingly, the Applicants respectfully request consideration of the prior art references cited in the Supplemental Information Disclosure Statement.

### **Claim Rejections – 35 USC §102**

Claims 50-55 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,545,374 to Jacobson (hereafter “the ‘374 patent”).

It is well established that “an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co. Ltd., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 50 has been amended to recite that the retractor body is provided with a channel adapted to “engagingly receive the retractor blade to maintain the retractor blade in a predetermined positioned relative to the retractor body.” As will be discussed below, independent claim 50, as amended, is submitted to be patentable over the ‘374 patent.

With regard to the ‘374 patent, the Office Action states that “Jacobson discloses a retractor/access device . . . comprising a retractor blade (distal portion of 18, Fig. 8), a retractor body (11) that is adapted for an unobstructed view (it has a cannula, which can provide a view from the outside to the inside) and a channel (see Fig. 8, shown as the cannula) . . .”. (Office Action, page 4, paragraph 1). However, the cannula 11 does not include a channel adapted to engagingly receive the retractor blade to maintain the retractor blade in a predetermined positioned relative to the retractor body. Even assuming arguendo that the distal portion of the rongeur forceps 18 are a retractor blade, the cannula 11 does not engagingly receive the forceps 18 to maintain the forceps in a predetermined position relative to the cannula. To the contrary, the cannula allows surgical instruments to freely move within its hollow tube and does not maintain the surgical instruments in a predetermined position relative to the hollow tube. (See e.g., column 7, lines 20-60).

For at least these reasons, the Applicants submit that the ‘374 patent does not teach or suggest each of the elements and features recited in independent claim 50, as now amended. Accordingly, the Applicants respectfully request withdrawal of the rejection of independent claim 50 as being anticipated by the ‘374 patent and request allowance of the same.

Dependent claims 51-54 depend from amended independent claim 50 and are submitted to be patentable for at least the reasons set forth above in support of the patentability of independent base claim 50.

New claims 63 and 64 have been added which depend either directly or indirectly from independent claim 50, and are submitted to be patentable for at least the reasons set forth above in support of the patentability of the corresponding independent base claim 50. Moreover, the subject matter recited in dependent claims 63 and 64 are patentable over '374 patent for other reasons as well. Additionally, new claims 63 and 64 are submitted to be fully supported by the subject application.

Independent claim 55 was also rejection as being anticipated by the '374 patent. The Applicant has amended independent claim 55 to recite that the retractor body is adapted for unobstructed view of the retracted area and includes "a first supporting member and a second supporting member, each of the first supporting member and second supporting member mounted to the retractor body and adapted for attaching a first and a second retractor pin, respectively . . .". Amended independent claim 55 further recites "the first retractor pin being attached to the first supporting member and the second retractor pin received for movement within the second supporting member."

With regard to the '374 patent, the Office Action states that "Jacobson discloses a retractor/access device . . . comprising . . . a retractor body (11) that is adapted for an unobstructed view (it has a cannula, which can provide a view from the outside to the inside) and a channel (see Fig. 8, shown as the cannula) . . . Jacobson also has at least one supporting member (30), that may be used for attaching a retractor pin (33)." (Office Action, page 4, paragraph 1). However, the '374 patent discloses that the cannula 30 includes a single tubular member 31, and therefore does not disclose a first supporting member and a second supporting member attached to the retractor body. (See, e.g., column 9, lines 17-21). Additionally, even assuming *arguendo* that '374 patent discloses a first supporting member and a second supporting member, the '374 patent does not disclose a first retractor pin that is attached to the first supporting member and a second retractor pin that is received for movement within the second supporting member. To the contrary, the '374 patent discloses that "the anchor means is one or more anchor wires 33 . . . the anchor wires are slidably inserting into one or more bores 34 defined by the member 31." (Column 9, lines 42-47). Both of the anchor wires disclosed in the '374 patent slide within bores 34.

For at least these reasons, the Applicants submit that the '374 patent does not teach or suggest each of the elements and features recited in independent claim 55, as now amended. Accordingly, the Applicants respectfully request withdrawal of the rejection of independent claim 55 as being anticipated by the '374 patent and allowance of the same.

New claims 65-70 have been added which depend either directly or indirectly from independent claim 55, and are submitted to be patentable for at least the reasons set forth above in support of the patentability of the corresponding independent base claim 55. Moreover, the subject matter recited in dependent claims 65-70 is patentable over the '374 patent for other reasons as well. Additionally, new claims 65-70 are submitted to be fully supported by the subject application.

#### **New Claims**

With this amendment, new claims 63-79 have been added and are submitted to be fully supported by the subject application. As indicated above, new claims 63 and 64 depend from independent claim 50, and new claims 65-70 depend from independent claim 55.

As to independent claim 71, the '374 patent fails to disclose, teach or suggest the claimed assembly including a retractor body having a support portion having a shape configured to provide an unobstructed view of a surgical site, and a retractor blade having a shape complimentary to the shape of the support portion. Therefore, independent claim 71 is submitted to be in condition for allowance. Claims 72-79 depend either directly or indirectly from independent claim 71 and are also submitted to be in condition for allowance.

## CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the Applicants' application is in condition for allowance with pending claims 50-55 and 63-79.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: 

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